At this time, in an earnest attempt to place this application in condition for allowance, Applicants have canceled all claims except claims 17-19.

Each of claims 17, 18 and 19 is directed to a specific compositional formulation of Example 1 of the present application which includes syndiotactic polypropylene "1". See Example 1 on page 8 and Table I on page 9 of the present application. The Examiner is respectfully requested to note that the ratio of components in Example 1 is 24 wt % of the polypropylene and 76 wt % of the EPDM rubber, plus 0.39 parts per weight of the specific α-α' bis(t-butylperoxy)-di-isopropylbenzene curative, as set forth in claims 17-19. Each of claims 17, 18, and 19 is based on the use of syndiotactic polypropylene "1" in which the EPDM has an ethylene content of 48% (EPDM "A" - claim 17), an ethylene content of 74% (EPDM "F" - claim 18) or an ethylene content of 77% (EPDM "G" - claim 19). As set forth at page 13, lines 1-2 beneath the heading "Table V", Polypropylene "1" has a syndiotactic pentad fraction of 0.86, also set forth in each of claims 17, 18, and 19.

From the above, each of claims 17, 18, and 19 is directed to a specific formulation of Example 1 of the present application, in which syndiotactic polypropylene "1" is employed with one of the three specific EPDM copolymers set forth in Table I, at page 9 of the application as filed.

Example 1 is set forth in each of Applicants' parent applications. In the parent applications, the syndiotactic pentad fraction of polypropylene "1" was not disclosed. However, the specific grade of syndiotactic polypropylene "1" was disclosed, which is set forth at the top of page 13, as grade G49M, from Hoechst AG. This material has a syndiotactic pentad fraction

of 0.86, as now specified. Thus, the additional information added to the present application is with respect to an inherent characteristic of the syndiotactic polypropylene "1" used in Example 1 of the present application, which example is found in each of Applicants' parent applications.

In the final rejection, claims 1-5 and 10-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Masuda et al.

In the Office Action, paragraph bridging pages 2 and 3, the Examiner submits that the limitations relating to syndiotactic pentad fraction of the instant propylene homopolymers are neither disclosed nor suggested in the parent applications. But, certainly the Examiner must acknowledge that the specific syndiotactic polypropylenes used in Applicant's examples do inherently have a certain syndiotactic pentad fraction. Those values are very specific syndiotactic pentad fraction values and were possesed by the syndiotactic polypropylenes as originally used in the Examples. Applicants at this time are claiming 3 of the specific formulations found throughout Applicants' chain of parent applications, and nothing more. Clearly, Applicants are entitled to claim specific formulations set forth in their application and in so doing can also set forth in such claims inherent features of those specific formulations. Applicants have done nothing more at this time.

Once it is accepted that Applicants are claiming three specific compositional formulations, which have existed in their chain of applications beginning with their first filed application, Masuda is antedated.

Concerning the law on inherency, Applicants enclose herewith for the Examiner's consideration the cases of Kennecott Corp. V. Kyocera International Inc., 5 USPQ2d 1194 (Fed Cir. 1987) and In re Nathan, 140 USPQ 601 (CCPA 1964).

In Kennecott, the issue was whether the claims of the '299 application, which specifically recited the microstructure of the claimed sintered ceramic body (a predominately equiaxed microstructure), were entitled to the benefit of the earlier '954 application based on inherency in the structure produced in the '954 application.

The only written description in the '299 application that was not present in the original '954 disclosure was the description and pictures of the products' microstructure. It was admitted that the products of Examples 1-30 did have the equiaxed microstructure, and that one skilled in the art could have readily determined the microstructure of the product.

The court decided, with approval of earlier law, that the expressed description of an inherent property was not "new matter", and could be added to the specification with effect as of the original filing date. The court concluded at page 1198, that "The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result"

The court cited with approval from its predecessor court, In re Nathan at 140 USPQ 601, 604 (CCPA 1964), where the court held that a later-added limitation to the claims of the compound's alpha orientation was "an inherent characteristic" of the claimed subject matter, and reversed a new matter rejection. The Nathan court explained that a subsequent clarification of or

change in the original disclosure does not necessarily make that original disclosure fatally defective." *Id* at 603.

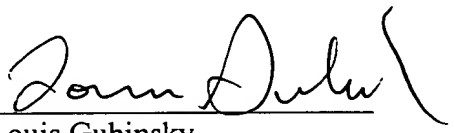
From Kennecott and Nathan, setting forth in specific compositional formulation claims 17, 18, and 19 the syndiotactic pentad fraction of the polypropylene used in those compositions does not amount to new matter, nor affect Applicants' benefit of Applicants' first filed application. In view of the above, Applicants submit that claims 17, 18 and 19 are allowable.

Finally, the undersigned expresses appreciation for the courtesy extended by the Examiner during a personal interview held at the Patent Office on April 5, 2001. At that time, the undersigned presented Applicants' inherency position substantially as explained in this amendment.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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Kennecott Corp. v. Kyocera International Inc. (CA FC) 5 USPQ2d 1194

Kennecott Corp. v. Kyocera International Inc.

U.S. Court of Appeals Federal Circuit
5 USPQ2d 1194

Decided December 22, 1987
No. 87-1151

Headnotes

PATENTS

1. Practice and procedure in Patent and Trademark Office -- Prosecution -- Filing date (§110.0906)

Patentability/Validity -- In general (§115.01)

Patentability/Validity -- Adequacy of disclosure (§115.11)

Grant of summary judgment to patent infringement defendant on grounds that patent holder's ceramic product patent was invalid under patentability bar of being "on sale" prior to application date under 35 USC 102(b), is error since earlier application for parent patent inherently described property of equiaxed microstructured ceramic product by its disclosure, and, despite not specifically naming such ceramic product, complies with 35 USC 120 and 112 for purposes of claiming benefit of earlier prior-to-sale application filing date of parent patent, and thus plaintiff's ceramic product patent is valid.

Particular patents -- Chemical -- Ceramic body

4,179,299, Coppola, Hailey and McMurtry, sintered alpha silicon carbide ceramic body having equiaxed microstructure, a crystal structure whose submicron grain sizes of silicon carbide are not highly elongated, do not have exaggerated grain growth, and are within a maximum-minimum dimension ratio of less than 3:1, holding of invalidity reversed.

Case History and Disposition:

Appeal from the U.S. District Court for the Southern District of California, Rhoades, J. 2 USPQ2d 1455 .

Plaintiff, Kennecott Corp., brought patent action against Kyocera International Inc. and Kyoto Ceramic Co. Ltd. From grant of summary judgment to defendant holding plaintiff's patent invalid, plaintiff appeals. Reversed.

Attorneys:

Clyde F. Willian (Willian Brinks Olds Hofer Gilson & Lione, Jack C. Berenzweig, and Raymond W. Green, with him on brief), Chicago Ill., for plaintiff-appellant Kennecott Corp.

Paul L. Gardner (Spensley Horn Jubas & Lubitz, Stuart Lubitz, Saul Epstein, and David L. Henty, with him on brief), Los Angeles, Calif., for defendants-appellees Kyocera International Inc. and Kyoto Ceramic Co. Ltd.

Judge:

Before Markey, Chief Judge, and Davis and Newman, Circuit Judges.

Opinion Text

Opinion By:

Newman, Circuit Judge.

Kennecott Corporation appeals the final judgment of the United States District Court for the

Southern District of California, 1 in which the district court granted summary judgment to the defendants Kyocera International and Kyoto Ceramic Co., Ltd. (together "Kyocera"), holding that United States Patent No. 179, 299 ("the '299 patent") is invalid in terms of the "on sale" bar of 35 U.S.C. §102(b). Kennecott's claim of patent infringement was dismissed. We reverse.

The Controlling Question

The judgment of invalidity turned on the sole question of whether the claims of the '299 patent are entitled, as a matter of law, to the benefit of the filing date of its parent patent application which eventually issued as U.S. Patent No. 4,312,954 ("the '954 application"), filed on June 5, 1975. If so entitled, the sales events in 1977 can not effect an invalidity bar. If not so entitled, Kennecott admits that its sales activities occurred more than one year before May 1, 1978, the filing date of the continuation-in-part application that issued as the '299 patent.

Background

On summary judgment all facts material to the result must be either undisputed or, if disputed, must be resolved in favor of the party opposing summary judgment. *Litton Industrial Products, Inc. v. Solid State Systems Corp* ., 755 F.2d 158, 163, 225 USPQ 34, 37 (Fed. Cir. 1985). Rule 56, Fed. R. Civ. Proc. The question of the sufficiency of the disclosure of the '954 application to support the '299 claims is a matter of law based on underlying facts. All facts material to the issue are here deemed undisputed, based on admissions by Kyocera for the purpose of its motion for summary judgment.

Kyocera states in its brief on appeal that it did not concede or admit all the facts that Kennecott says it did. The district court found, however, that:

Finding 11. For the purposes of this Motion only, the material facts set forth in all of the affidavits and in all of the exhibits submitted by plaintiff in opposition to Defendants' Motion, are undisputed by defendants.

Kyocera has not assigned error to this finding, and it is bound thereby.

The continuation-in-part '299 application contains a substantial part of the disclosure of the '954 parent application, plus a description of and photomicrographs showing the

equiaxed microstructure. 2 It is not disputed that the photomicrographs were of the product made and described in the '954 application, and produced in the original examples.

The '299 patent claims contain the words "equiaxed microstructure" that were not present in the '954 specification and claims. This is the only difference at issue. '299 patent claim 1 is representative:

1. A sintered ceramic body consisting essentially of:

(a) from about 91 to about 99.85% by weight silicon carbide, wherein at least 95% by weight of the silicon carbide is of the alpha phase;

(b) up to about 5.0% by weight carbonized organic material;

(c) from about 0.15 to about 3.0% by weight boron; and

(d) up to about 1.0% by weight additional carbon;

and having a predominantly equiaxed microstructure.

Pertinent undisputed or conceded facts include the following:

the high (over 95%) alpha silicon carbide ceramic body that is described in the '954 application has an equiaxed microstructure;

the '954 application does not mention the equiaxed microstructure of the high-alpha silicon carbide ceramic body, nor state the requirements for forming such microstructure;

the inventors knew that the high-alpha silicon carbide ceramic body had an equiaxed microstructure, and it was known that ceramics from high-alpha silicon carbide could have this structure;

examples 1-30 in the '954 application, all the examples using high-alpha silicon carbide, all produce a ceramic body having an equiaxed microstructure;

the method set forth in the '954 application using the high-alpha silicon carbide invariably produces a ceramic product having an equiaxed microstructure.

Kennecott asserts that the equiaxed microstructure is inherent in the structure produced in the '954 application, and that the '299 claims, which specifically name the equiaxed structure, therefore enjoy the benefit of the earlier filing date. Kennecott also asserts, and Kyocera denies, that Kyocera conceded the question of inherency in the course of conceding all disputed facts on its motion for summary judgment.

It is apparent that Kyocera conceded the factual premises 3 of inherency by conceding that examples 1-30 produced, without undue experimentation, a product having an equiaxed microstructure. What is disputed is the legal implication of this inherent production of an equiaxed product.

The district court concluded that for the '954 specification to meet the written description requirement, one reading the specification must know from the "four corners" of the document, without recourse to information outside the specification, that the ceramic product has an equiaxed microstructure. The district court held that the specification of the '954 application met the enablement requirement of section 112 but not the written description requirement, and thus that it was immaterial that the product disclosed in the '954 application was the same as that claimed in the '299 patent.

Discussion

For the '299 claims to receive the benefit of the '954 application's filing date, 35 U.S.C. § 120 requires, inter alia, that the invention of the claims be disclosed in the '954 specification in the manner required by 35 U.S.C. § 112, first paragraph, which provides:

§ 112 ¶1: The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The purpose of section 112, first paragraph, is to ensure that there is an adequate disclosure of the invention for which patent rights are sought. The purpose of the description requirement of this paragraph is to state what is needed to fulfill the enablement criteria. These requirements may be viewed separately; but they are intertwined.

The incorporation of the requirements of section 112 into section 120 ensures that the inventor had possession of the later-claimed invention on the filing date of the earlier application. *In re Edwards* , 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). The written description must communicate that which is needed to enable the skilled artisan to make and use the claimed invention. A description that does not meet this requirement is legally insufficient. *In re Wilder* , 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), *cert. denied* , 469 U.S. 1209 (1985).

It was undisputed that the only written description in the '299 application that was not present in the original '954 disclosure was the description and pictures of the product's microstructure. Kennecott points to authority that the added description of a property of a previously disclosed product does not deprive claims to that product of the benefit of a prior disclosure of the product. Kyocera responds that because the '954 specification is silent as to the microstructure of the product, and because one would not know whether the product had an equiaxed microstructure merely by reading the specification, the specification is inadequate in law to support claims that require an equiaxed microstructure. Kyocera also asserts that the equiaxed microstructure is not obtained without physical manipulation of the process of the '954 application, and that any concession it may have made as to production of an equiaxed product is limited to the specific conditions used in examples 1-30 of the '954 specification.

Taking the last contention first, it was admitted that the products of examples 1-30 have the equiaxed microstructure, and that one skilled in this art could readily determine the microstructure of the product. Kyocera's arguments on appeal as to the need for manipulation of conditions are contravened in the affidavit evidence referred to in Finding of Fact 11, *supra* .

We conclude that it was established before the district court that the high-alpha products of the '954 application have the equiaxed microstructure.

On the issue of sufficiency of the earlier disclosure, the body of precedent teaches that the legal conclusion depends on the particular facts. In *In re Edwards* the court considered a chemical compound that was not described in the earlier application, and stated that the earlier and later applications need not use the identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it. The court observed that the chemical reactions described in the earlier filing "will inherently produce, as the predominant component, the [later claimed] compound". 568 F.2d at 1352, 196 USPQ at 467. The facts in *Edwards* are strongly analogous to those herein, for Kennecott's '954 examples 1-30 all produce a ceramic that has an equiaxed structure.

The facts before us are not like those discussed in *In re Ruschig* , 379 F.2d 990, 154 USPQ 118 (CCPA 1967), referred to by the district court, but are analogous to those discussed in *In re Reynolds* , 443 F.2d 384, 170 USPQ 94 (CCPA 1971). In *Reynolds* the question was whether words describing a function that was inherent in the claimed product could be added to the specification by amendment, or whether such description was "new matter". The court cited with approval the holding in *Technicon Instruments Corp. v. Coleman Instrument, Inc* ., 225 F.Supp. 630, 640-41, 150 USPQ 227, 236 (N.D. Ill. 1966), *aff'd* , 385 F.2d 391, 155 USPQ 369 (7th Cir. 1967), that:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory, or advantage even though he says nothing concerning it.

Quoted at 433 F.2d at 389, 170 USPQ at 98. It was concluded that the express description of the inherent property, since not "new matter", could be added to the specification with effect as of the original filing date.

The Court of Customs and Patent Appeals has long recognized that an invention may be described in different ways and still be the same invention. In *In re Kirchner* , 305 F.2d 897, 904, 134 USPQ 324, 330 (CCPA 1962), the court held that compliance with section 120

does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.

Id . In *Kirchner* the court authorized the addition to the specification of descriptive matter concerning the use of the compounds without loss of the parent application's filing date. In the '299 patent, by contrast, the additional material was added not only to the specification, but to the claims. Thus Kyo

cera argues that it is immaterial that the product in the '299 claims is inherently the same as that produced in the '954 application, because unlike *Kirchner* the '299 claims include the new

descriptive matter.

The Court of Customs and Patent Appeals did not adopt the position that is now urged by Kyocera. In *In re Nathan* , 328 F.2d 1005, 1008-09, 140 USPQ 601, 604 (CCPA 1964), the court held that the later-added limitation to the claims of the compound's alpha orientation was "an inherent characteristic" of the claimed subject matter, and reversed a new matter rejection. The *Nathan* court explained that "a subsequent clarification of or a change in an original disclosure does not necessarily make that original disclosure fatally defective." *Id* . at 1008, 140 USPQ at 603.

Kennecott argues that Kyocera is pressing the position rejected in *Kirchner* , wherein the court cautioned that it is necessary to avoid confusing "the invention itself which is the subject matter claimed . . . with one of the factors which is taken into consideration in determining whether the invention is or is not patentable from the standpoint of meeting 35 U.S.C. 103." *Id* . at 903-04, 134 USPQ at 329-30. The *Kirchner* court held that it was not required "that a parent case disclose the same utility as a later application to entitle the latter to the benefit of the filing date of the parent." *Id* . at 904, 134 USPQ at 330. In the case at bar the additional description was not of a new use, but of the existing physical structure of the product. On the basis of this precedent, the inclusion of the existing microstructure as a descriptive term in the '299 claims does not cause the '299 claims to lose their entitlement to the date of the first-filed '954 application.

The district court relied on *Langer v. Kaufman* , 465 F.2d 915, 918, 175 USPQ 172, 174 (CCPA 1972). In *Langer* the diffraction pattern specifically recited in an interference count was not expressly described in the specification. The court held, "To prove inherency, the burden is on appellants to show that the 'necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to . . . [this] positive limitation in the interference count.' " *Id* . (emphasis omitted) (quoting *Binstead v. Littmann* , 242 F.2d 766, 770, 113 USPQ 279, 282 (CCPA 1957)). The issue in *Langer* was entitlement to the benefit of constructive reduction to practice, which the court denied despite evidence that one of the experiments, Run E, produced the claimed diffraction pattern. The court has generally applied this standard of the "necessary and only reasonable construction" as a basis for determining whether an application could, on the basis of an inherent property, support a limitation in an interference count. *See, e.g., Wagoner v. Barger* , 463 F.2d 1377, 1380, 175 USPQ 85, 86-87 (CCPA 1972); *Snitzer v. Etzel* , 531 F.2d 1062, 1076, 189 USPQ 415, 419 (CCPA 1976). This standard, arising in the interference context, is consistent with that of the other cases on the issue of compliance with section 112, first paragraph.

[1] In this case, the invention of the '299 claims is a ceramic product. That product is the same as the product in the '954 application, and has the same structure. It was conceded that anyone with a microscope would see the microstructure of the product of the '954 application. The disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result.

We conclude that the district court erred in holding that the '299 claims were not entitled to the '954 filing date.

REVERSED

Footnotes

Footnote 1. *Kennecott Corporation v. Kyocera International, Inc. and Kyoto Ceramic Co., Ltd* ., No. 80-0516 R(M) (S.D. Calif. Dec. 17, 1986).

Footnote 2. "Equiaxed microstructure" is the crystal structure of the silicon carbide in submicron size grains that are not highly elongated and that do not have exaggerated grain growth. As defined in the '299 patent the ratio of the maximum dimension of the grains to the minimum dimension is less than 3:1.

Footnote 3. Kyocera raises on this appeal factual issues that appear to contradict its concessions before the district court, including issues related to Kennecott's representations to the patent examiner in prosecuting the '299 application. However, it is too late in the proceeding for Kyocera to retreat from its blanket concession of the factual issues.

- End of Case -

In re NATHAN, HOGG, AND SCHNEIDER

(CCPA)
140 USPQ 601

Decided Mar. 12, 1964
Appl. No. 7145
U.S. Court of Customs and Patent Appeals

Headnotes

PATENTS

1. Amendments to patent application--New matter (§13.5)

Subsequent clarification of or a change in original disclosure does not necessarily make that original disclosure fatally defective; thus, amendatory material is not new matter where it is concerned with an inherent characteristic of an illustrative product of applicants' invention already sufficiently identified in original disclosure.

Particular patents--Steroids

Nathan, Hogg, and Schneider, Steroids, claims 1 to 16 of application allowed.

Case History and Disposition:

Appeal from Board of Appeals of the Patent Office.

Application for patent of Alan H. Nathan, John A. Hogg, and William P. Schneider, Serial No. 759,400, filed Sept. 8, 1958; Patent Office Mechanized Division A. From decision rejecting claims 1 to 16, applicants appeal. Reversed.

Attorneys:

EUGENE O. RETTER and G. A. BLAUFARB, both of Kalamazoo, Mich., for appellants.

CLARENCE W. MOORE (J. E. ARMORE of counsel) for Commissioner of Patents.

Judge:

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

Opinion Text

Opinion By:

MARTIN, Judge.

This appeal is from a decision of 'the Patent Office Board of Appeals affirming the examiner's rejection of claims 1 through 16 of appellants' application serial No. 759,400, filed September 8, 1958 for "Steroids." No claim has been allowed.

The appealed claims are directed to certain 2-halo (fluorine or chlorine) steroids, the compound 2-halo (fluoro- or chloro-)- 17 *a,* 21-dihydroxy-4-pregnene-3,20-dione being representative of the claimed compounds. All the claims further, as the result of an amendment entered during prosecution of the application before the Patent Office, specify the alpha (a) orientation for the 2-halo substituent.

The relationship of the 2-halo atom to the steroid nucleus of the claimed steroids can be represented diagrammatically as:
Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

The 2-position of the molecule of appellants' steroids is represented by saturated carbon atom C 2. Saturated carbon atom C 2is bonded to saturated carbon atoms C 1and C 3, to the hydrogen substituent and to the fluorine or chlorine substituent.

Appellants point out that because of the relation of the valence bond angles of the saturated carbon atoms of the steroid, one of the two substituents attached to saturated carbon atom C 2will project toward one side of the approximate plane of the steroid nucleus and the other substituent toward the other side of that plane. The substituent which projects toward the opposite side from the angular methyl groups (carbon atoms C 18and C 19) is said to have the alpha orientation,

whereas the substituent projecting toward the same side from the angular methyl group is said to have the beta orientation.

The record shows that on June 15, 1959 appellants amended their specification and claims to indicate that the 2-halo steroids of their invention had the alpha orientation. This amendment was in response to the examiner's first action on the claims. That action, according to the examiner's answer, "merely rejected the claims as unduly broad and indefinite in failing to give the configuration (alpha or beta) of the 2-halo atoms." On June 2, 1960 appellants submitted an affidavit under Rule 132 in support of the propriety of their amendment, which affidavit reads in part:

> That, the synthesis of the steroid compounds accomplished in the course of completing the invention described and claimed in the above-identified application involved, in the case of the 2-fluoro compounds, the introduction of a fluorine atom in the 2-position of a certain D 4-3-keto steroid of the pregn *a* ne [sic] series; namely, an alkali metal enolate of 2-alkoxy-oxalyl-11b 21-dihydroxy-4, 17(20)-[cis]-pregnadien-3-one (Preparation 6 of the specification) by reaction with perchloryl fluoride to produce 2-fluoro-2-alkoxyoxalyl-11b, 21-dihydroxy-4,17 (20)-[cis]-pregnadien-3-one;
>
> That, this latter compound was then converted to a 2-fluorinated-11b, 21-dihydroxy-4,17(20-[cis]-pregnadien-3-one (the product of Preparation 6 of the specification);
>
> That, we are aware of the work of others wherein a fluorine substituent has been introduced by the reaction of perchloryl fluoride upon the 2-alkoxy-oxalyl substituted D 4-3-keto steroid (Kissman et al., J.A.C.S. 81:1262); * * * and we are moreover aware that in * * * [that work] the stereo-configuration of the 2-fluorine substituent is designated as the a-configuration based, * * * upon physical evidence consistent with such a con

> figuration; and moreover we are unaware of any facts inconsistent therewith;
>
> That, we converted the product of Preparation 6 of the specification to 2-fluoro hydrocortisone acetate by the process of Preparation 7 and Example 1 and that we hydrolyzed the product of Example 1 by the process of Example 6 thus producing 2-fluoro hydrocortisone;
>
> That, in the case of the Kissman et al. work, we have made a comparison and found that our 2-fluoro hydrocortisone, prepared by the hydrolysis of the product of Example 1 of the specification and have found physical characteristics consistent with and no physical characteristics inconsistent with the identity thereof;
>
> That, these physical constants are:
>
> For the 2-fluoro hydrocortisone prepared by hydrolysis of our Example 1 by the

process of Example 6 of the specification:

> Conjugated ketone band at 5.97 m. lmax at 242 mm, E 14,200 (in ethanol). aD plus 185 degrees (methanol). Melting point 212-221 degrees centigrade.

The physical characteristics reported by Kissman et al. are:

> Conjugated ketone band at 5.87 m. lmax 241mg, E 14,800. aD plus 190 degrees (methanol). Melting point 216-220 degrees centigrade.

That, the product of our Example 6 is identical with the product designated as 2a-fluoro hydrocortisone of Kissman et al.;

That, the subsequent chemical conversions to which the compounds disclosed and claimed in the above-identified application for patent are subjected do not alter the stereoconfiguration of the 2-fluoro substituent;

In rejecting the claims, the examiner took the position that the alpha configuration of the 2-halo substituent is not inherent in the compounds disclosed in the case as originally filed and since the configuration of the 2-halo substituent was not included in the application as filed, it may not be entered at a later date.

The board held that amendatory material, designating the 2-halo substituent as alpha oriented, has no basis in the original disclosure and thus is in violation of the last sentence of 35 U.S.C. 132 [1] which prohibits the introduction of new matter. The board was not convinced of any error in the examiner's rejection and stated that it was "not satisfied that extraneous evidence discovered after the filing of the application can be used as support for a stereoconfiguration not originally disclosed." Regarding the Rule 132 affidavit the board stated:

> The difficulty with the Rule 132 affidavit is that appellants attempt to identify their compounds on the basis of the knowledge of others acquired after the filing date of the instant application. * * *

Appellants urge that the application as filed taught those skilled in the steroid art how to prepare and identify the claimed 2-halo steroids and that accordingly the amendatory material does not constitute new matter. It is contended that the amendment merely defines more precisely for those skilled in the art the 2-halo steroids inherently produced by the process of the application as filed and identified therein by physical characteristics.

It seems to us that the issue here is whether appellants' identification of their 2-halo steroids in their original disclosure is adequate to identify the claimed subject matter and whether there is sufficient evidence in the record to show the alpha orientation to be an inherent characteristic of the subject matter so identified. If the answers are in the affirmative then appellants' amendment specifying the alpha orientation for the 2-halo substituent is not new matter but rather is merely a statement of an inherent property of the steroids as disclosed in appellants' original disclosure.

[1] A subsequent clarification of or a change in an original disclosure does not necessarily

make that original disclosure fatally defective. This court in Reister v. Kendall, 34 CCPA 859, 159 F.2d 732, 72 USPQ 481 , dealt with an interference in which a count was directed to certain dyestuffs. Appellee relied on a British provisional specification for constructive reduction to practice although the structural formulae

given for the identification of the respective products of the reaction in appellee's British specification *differed* from the corrected formulae for the same products recited in his U.S. application. The board nevertheless, in finding for appellee, held that his British specification disclosed the dyestuffs and the means for identifying them irrespective of the wrong formulae and thus was a sufficient disclosure of the patentable subject matter. This court found no error in the board's decision.

We think appellants' identification of their 2-halo steroids in their original disclosure sufficiently identifies the claimed subject matter. Appellants' original disclosure was specifically directed to a generic class of 2-halo steroids which steroids were chemically named, no question being presented as to their nomenclature aside from the orientation of the halogen at the 2-position of the steroid nucleus. Appellants' Example 1, which is stated in the application to be illustrative of the "products of the present invention," gave a definite melting point range, optical rotation, ultraviolet spectral analysis and chemical analysis for the product obtained therein. Appellants have further shown through an affidavit that the hydrolysis [2] of the product of their Example 1 of their application yields a 2-fluoro hydrocortisone which has physical constants consistent with a product designated in the art as 2a-fluoro hydrocortisone. Such evidence, we think, is adequate to demonstrate an inherent characteristic (the alpha orientation) of appellants' claimed subject matter.

Thus, we consider that the amendatory material of June 15, 1959 is concerned with an inherent characteristic of an illustrative product of appellants' invention already sufficiently identified in appellants' original disclosure as filed. Such amendment is not prohibited by the statute. In Ex parte Davisson and Finlay, 133 USPQ 400, 402, for example, the board noted that the examiner had entered an amendment reciting the optical rotation data and elemental analysis of the sulfate of a claimed substance as well as the spectroscopic characteristics of the claimed substance "apparently regarding them as a statement of inherent properties of the material adequately disclosed" in an original disclosure and stated that it saw no reason for "taking a different view of the matter." We think the case at bar presents an analogous situation.

For the foregoing reasons, the decision of the board is *reversed.*

Footnotes

Footnote 1. 35 U.S.C. 132 reads:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Footnote 2. Appellants have stated in their affidavit that the subsequent chemical conversions of their Example 1 compound do not alter the stereoconfiguration of the 2-fluoro substituent and there is nothing in the record to controvert that statement.

- End of Case -

